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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,529	03/31/2004	Christian L. Critz	16356.765 (DC-03294A)	6902

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EXAMINER

GELIN, JEAN ALLAND

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,529

Applicant(s)

CRITZ ET AL.

Examiner

Jean A. Gelin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/31/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Itoh et al. (US 2002/0072391).

Regarding claims 1, 15, Itoh teaches an information handling system (figs. 1, 2), comprising: a processor for coupling to a memory (switching mechanism and storage, section 41); a connector for receiving a removable wireless device (for connecting the computer to network, section 43); a fixed network controller (within utility 11 for enable/disable adapter, section 46); an indicator, shared between the wireless device and the network controller, for indicating multiple non-zero communication speeds of the wireless device, and for indicating multiple non-zero communication speeds of the network controller (displaying icons based on priority for notifying user the communication device that is available to access (sections 44, 46, and 58-60), typically in a computer shape, color, size, and order of icons representing communication devices can be varied).

Regarding claims 2, 16, Itoh teaches wherein at least one communication speed of the network controller is different from the communication speeds of the wireless device (typically wireless land card, PCI adapter, and Ethernet adapter have different communication, sections 66-69).

Regarding claims 3, 17, Itoh teaches wherein at least one communication speed of the wireless device is different from the communication speeds of the network controller (typically wireless land card, PCI adapter, and Ethernet adapter have different communication, sections 66-69).

Regarding claims 4, 18, Itoh teaches wherein the communication speeds of the wireless device include at least three communication speeds (priority level 1, 2, and 3, section 60).

Regarding claims 5, 19, Itoh teaches wherein the communication speeds of the network controller include at least three communication speeds (priority level 1, 2, and 3, section 60).

Regarding claim 6, 20, Itoh teaches wherein the indicator is a first indicator, and comprising: a second indicator, shared between the wireless device and network controller, for indicating network activity (enabled/disabled adapters are displayed to show network activity, sections 49-50, 66).

Regarding claims 7, 21, Itoh teaches wherein the indicator is for indicating a working wireless network connection and for indicating a working wired network connection (enabled/disabled adapters are displayed to show network activity, sections 49-50).

Regarding claims 8, 22, Itoh teaches wherein the indicator includes at least first and second indicators for indicating the communication speeds (enabled/disabled adapters are displayed to show network activity, sections 49-50, 66).

Regarding claims 9, 29, Itoh teaches: status processing logic for overriding the wireless device sharing of the indicator when the network controller is connected to a wired network, so that access to the indicator is provided to the network controller instead of the wireless device (sections 58-60, 66).

Regarding claim 10, Itoh teaches wherein the indicator is integrated in a wired connector (fig. 2).

Regarding claim 11, Itoh teaches wherein the network controller is fixably attached to a motherboard (fig. 2).

Regarding claim 12, Itoh teaches wherein the connector is fixably attached to a motherboard, and wherein the wireless device is removably attachable to the connector (section 66).

Regarding claim 13, Itoh teaches wherein the connector is a mini-PCI adaptor (section 66).

Regarding claim 14, Itoh teaches wherein the wireless device is a mini-PCI wireless card (section 66).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/056,378. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-20 of the copending contain every element of claims 1-23 of the instant application and as such anticipate claims 1-23 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

"A later application claim is not patentably distinct from an earlier application claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the

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Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bultman	US 6,804,536	10/12/2004
Sandler et al.	US 5,983,117	11/09/1999

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGelin
September 1, 2005

